



AF/ GAU 17728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application : Bakker, W.
Serial No. : 08/977,374
Filed : November 24, 1997
For : SHRINKING FILM ONTO AN OPEN
TOPPED CONTAINER
Examiner : W. Watkins III
Art Unit : 1772
Last Office Action : June 20, 2000
Attorney Docket No. : PZN 20017

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Cleveland, Ohio 44114-2518
August 21, 2000

REPLY BRIEF UNDER 37 C.F.R. §1.193

Assistant Commissioner
for Patents
Washington, D.C. 20231

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Dear Sirs:

This Reply Brief is submitted (in triplicate) in response to the Examiner's Answer issued on June 20, 2000 in the above referenced patent application.

REMARKS

In the Examiner's Answer, the Examiner maintains a rejection based on obviousness-type double patenting over claims 1, 3, 4, 5 and 19 of U.S. Patent No. 5,993,942. The Examiner indicates that while the claims are not identical, they are not patentably distinct because, in the Examiner's opinion, the claims differ only in the language used to describe the same structure (See Examiner Answer, p. 5, paragraph no. 2).

Additionally, in spite of issuing an obviousness-type double patenting rejection over issued U.S. patent claims, the Examiner maintains a rejection under 35 U.S.C. §103(a) over Heilman et al. (AU 27,337) in view of Konger (U.S. 3,760,154) further in view of

Anderson et al. (U.S. 5,113,479).

Appellants would like to point out that during the prosecution of the patent identified in the obviousness-type double patenting rejection (U.S. 5,993,942), the Examiner was aware of this application in that a provisional obviousness type double patenting rejection was also issued in that application over the present application. Also, the Examiner of the application which resulted in the '942 patent chose to use Heilman et al. and Anderson et al. in a prior art rejection. However, such art was overcome and the claims were held allowable thereover.

In spite of the above, the Examiner in this application continues to maintain both 1) the prior art rejection using both Heilman et al. and Anderson et al. (and also Konger) and 2) the obviousness type double patenting rejection over the '942 patent where Heilman et al. and Anderson et al. were already considered and overcome. Appellants believe such inconsistent prosecution by the U.S. Patent and Trademark Office is detrimental to the value of issued U.S. patents as it calls into question the presumption of validity under 35 U.S.C. §282 of issued U.S. patents.

Aside from the above, Appellants would like to again point out some inaccuracies in the Examiner's assessment of the cited art.

In the rejection of page 4, §10, paragraph No. 1 of the Examiners Answer, the Examiner continues to describe each of Heilman et al. and Konger as teaching use of infrared radiation to shrink transparent film.

Once again, as adamantly emphasized in the Appeal Brief, Appellants would like to point out that infrared radiation applied to transparent film, by itself, will pass directly through the film. No shrinkage will occur without the claim designated modification to the film. Each of Heilman et al. and Konger rely on the infrared radiation to heat an opaque surrounding surface which, in turn, heats the air wherein said hot air causes the shrinkage of the transparent film. This is simply not the Appellants invention.

Appellants have modified the film itself to be absorbent to radiant energy thereby providing for a mechanism to effectuate preferential shrinkage of the film at those locations having said opaque portions thereon. Even if, as the Examiner contends in the Examiner's Answer at p. 6, that the load behind the transparent film heats the film (as suggested by Konger), that is not what is being claimed nor would preferential shrinkage of the film be attained. In fact, Konger specifically recites that it is infrared radiant *heat* which

causes said film to shrink. This heat is generated from the load or the surrounding oven and not the film itself. The present claims recite a modified film having means to absorb radiant energy on the film itself. In this manner, the preferential shrinkage can be attained.

Anderson et al., in contrast to the Examiner's assertions, is directed to a completely unrelated problem. Anderson is concerned with applying infrared radiation to a specific location on an entirely opaque material (a package). The infrared radiation is directed to particular spots via reflectors to avoid heating (and subsequent melting) of the entire surface of the thermoplastic material. Various portions of the thermoplastic laminate may be preprinted with a colored strip to enable less infrared radiation to be used when heating the material.

Thus, a critical difference in Anderson is that Anderson does not concern transparent shrink wrap technology at all. Anderson is concerned with melting (as opposed to shrinking) a thermoplastic laminate on a packaging material at specified locations to enable welding on a packaging material. The colored markings are optional in Anderson as the entire laminated material is opaque and thus able to generate heat when supplied with radiant energy. None of the problems associated with shrink wrap technology are addressed by Anderson as Anderson is concerned with an entirely different problem. Anderson *limits* the exposure area of the infrared radiation which converts radiant energy to heat. Applicants have done exactly the opposite. Applicants have *increased* the area of a transparent shrink wrap film which converts radiant energy to heat energy. This is clearly not taught nor suggested by Anderson, either alone or in combination with Heilman and/or Konger.

As such, the Examiner has provided no motivation to combine the teachings of the cited art. When considering the teaching of a particular reference, it is the teaching of the reference, as a whole, which must be considered. It is not proper for the Examiner to "pick and choose" selected portions of the cited art and, with the benefit of the Applicants disclosure, render the claims obvious. The teachings must be viewed in their entirety, including any teaching away from the invention. In the present case, the Examiner has simply ignored the overall teaching of the references and merely combined the unrelated art using the present disclosure as a motivation to do so.

The Applicants were first to realize the benefits of *adapting* a heat shrinkable film to directly absorb radiant energy such as infrared energy, instead of using the same indirectly to heat the air, which then impinges on the film as taught by both Heilman and Konger.

In view of the foregoing, the Applicants submit that the invention as presently claimed is not obvious in light of either Heilman, Konger or Anderson, whether taking singly or in combination as the Examiner has suggested.

CONCLUSION

It is submitted that claims 36-46 are patentable over the cited art for the reasons set forth in the Appeal Brief and those set forth herein.

Appellants' respectfully request that the Examiner's rejection be reversed.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this Reply Brief Under 37 C.F.R. §1.193 in connection with U.S. Patent Application Serial No. 08/977,374 is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on August 21, 2000.



Dottie M. Freeland